FILE COPY

Office-Supreme Court, U.S.
FILED
OCT 8 1959
JAMES R. BROWNING, Clerk

# Supreme Court of the United States

**October Term, 1959**

No. 299

SCRIPTO, INC.,

*Petitioner,*

v.

FERBER CORPORATION,

*Respondent.*

## Respondent's Brief in Opposition to Petition for Writ of Certiorari to the United States Court of Appeals for the Third Circuit

MAXWELL E. SPARROW,
*Attorney and Counsel for Respondent,*
665 Fifth Avenue,
New York 22, N. Y.

MILTON ROSENKRANZ,
*Attorney and Counsel for Respondent,*
921 Bergen Avenue,
Jersey City 6, N. J.

LODER APPEAL PRESS, INC., 65 Duane Street, N. Y. C. WOrth 2-0689.

# INDEX


| | PAGE |
|---|---|
| Introductory Statement | 1 |
| Concerning Petitioner's "Statement of the Case" (Pet., p. 3) | 5 |
| ARGUMENT: | |
| POINT I.—There is no conflict between the decision of the Third Circuit below, and the Seventh Circuit decisions relied on by petitioner | 6 |
| POINT II.—The decision below did not turn on the questions posed by petitioner herein; rested on factual findings of prior art anticipation, compelling a determination of invalidity | 11 |
| CONCLUSION | 14 |


## CASES CITED


| | |
|---|---|
| American Soda Fountain Co. v. Sample, 130 Fed. 145 (3rd Cir. 1904), cert. den. 195 U. S. 634, 49 L. Ed. 354 | 8 |
| Benjamin Electric Mfg. Co. v. Bright Light Reflector Co., Inc., 111 F. 2d 880 (1940) | 7, 9 |
| Boynton v. Chicago Hardware Foundry Co., 77 F. 2d 799 (1935) | 7, 9 |
| Crosley Corp. v. Westinghouse Electric & Mfg. Co., 152 F. 2d 895, 3rd Cir. 1945 | 12 |

PAGE

Dole Refrigerating Company v. Amerio Contact Plate Freezers, Inc., 265 F. 2d 627 (1959) ..... 6

France Mfg. Co. v. Jefferson Electric Co., 106 F. 2d 605 (1939) cert. den. 309 U. S. 657, 84 L. Ed. 1006 (1940) ..... 7

Fritz W. Glitch & Sons, Inc. v. Wyatt Metal & Boiler Works, 224 F. 2d 331 (1955) ..... 7

Gerald M. Friend, Inc. v. Walsh, 141 F. 2d 180 (1944) ..... 6, 8

Gillette Safety Razor Co. v. Cliff Weil Cigar Co., Inc., 107 F. 2d 195 (1939) ..... 7, 8

Gomez v. Granat Bros., 177 F. 2d 266 (1949), cert. den. 338 U. S. 937, 94 L. Ed. 578 (1950) ..... 7

Hamilton Laboratories, Inc. v. Massengrill, 111 F. 2d 584 (1940) cert. den. 311 U. S. 688, 85 L. Ed. 444 ..... 7

Hobles v. Wisconsin Power & Light Co., 250 F. 2d 100 (1957) ..... 7, 9, 11

R. Hoe & Co. v. Goss Printing Press Co., 30 F. 2d 271 (1929) ..... 6

Huston v. Buckeye Bait Corp., 145 F. Supp. 600, S. D. Ohio 1955, aff'd 237 F. 2d 920, 6th Cir., 1956 ..... 12

Jacuzzi Brothers, Inc. v. Berkeley Pump Co., 191 F. 2d 632 (1951) ..... 7

Johnson Laboratories, Inc. v. Meissner Mfg. Co., 98 F. 2d 937 (1938) ..... 7, 8, 9

PAGE

Layne and Bowler Corp. v. Western Well Works, 261 U. S. 387, 393, 67 L. Ed. 712, 1923 ..... 1

Lempco Products, Inc. v. Timken-Detroit Axle Company, 110 F. 2d 307 (1940) cert. den. 311 U. S. 675, 85 L. Ed. 434 ..... 7

Lewyt Corp. v. Healthmor, Inc., 181 F. 2d 855, 7 Cir., 1950, cert. den., 340 U. S. 823, 95 L. Ed. 605, 1950 ..... 12

Maibohm v. R. C. A. Victor Co., 89 F. 2d 317 (1937) 7

Messing v. Quiltmaster Corp., 162 F. Supp. 489 (D. N. J. 1958) ..... 6

Moran v. Protective Equipment, Inc., 84 F. 2d 927 (1936) ..... 7, 9

National Electric Products Corp. v. Grossman, 70 F. 2d 257 (1934) ..... 6

Niash Refining Co., Inc. v. Azor, Inc., 158 F. Supp. 505 (D. R. I. 1957) ..... 6

Nordell v. International Filter Co., 119 F. 2d 948 (1941) ..... 7, 9

O'Leary v. Liggett Drug Company, 150 F. 2d 656, 664 (1945) cert. den. 326 U. S. 773, 90 L. Ed. 467 ..... 7, 8

Osborn Mfg. Co. v. Newark Brush Co., 111 F. Supp. 846 (D. N. J. 1953) ..... 6

Radio Corp. of America v. Radio Engineering Laboratories, Inc., 293 U. S. 1, 79 L. Ed. 163 (1934) 11

Robinson Aviation Inc. v. Barry Corp. (D. Mass. 1952) 103 F. Supp. 514 ..... 6

PAGE

Rock-Ola Mfg. Corp. v. Cusano, 106 F. Supp. 723 (D. N. J. 1952) ..... 6

Rohr Aircraft Corp. v. Rubber Teck, Inc., 266 F. 2d 613 (1959) ..... 7, 8

Rosaire v. Baroid Sales Division National Lead Co., 218 F. 2d 72 (1955), cert. den. 349 U. S. 916, 99 L. Ed. 1249 ..... 7

Rothe v. Ford Motor Co., 253 F. 2d 353, D. C. Cir. 1958 ..... 12

Royal Patent Corp. v. Monarch Tool & Mfg. Corp., 203 F. 2d 299 (1953) ..... 7

H. Schindler & Co., Inc. v. Saladino & Sons, Inc., 81 F. 2d 649 (1936) ..... 6, 8

Selas Corp. of America v. Purolator Products, Inc., 159 F. Supp. 682 (D. N. J. 1958) ..... 6

Slagboom v. Van Vlaanderen Machine Co., 139 F. Supp. 785 (D. N. J. 1956) ..... 6

Specialty Equipment & Machinery Corp. v. Zell Motor Car Co., 113 F. Supp. 161 (D. Md. 1953) ... 7

Steffon v. Weber Heating and Sheet Metal Co., 237 F. 2d 601, 8th Cir. 1956 ..... 11

United States Air Conditioning Corp. v. Governair Corp., 216 F. 2d 430, 10th Cir. 1954 ..... 11

Western Auto Supply Co. v. American-National Co., 114 F. 2d 711 (1940) ..... 7

Westinghouse Electric & Mfg. Co. v. Formica Insulation Co., 266 U. S. 342, 69 L. Ed. 316 (1924) ... 7, 11

PAGE

Westinghouse Mfg. & Elec. Co. v. Toledo, P. C. & L. Ry. Co., 172 Fed. 371 (1909) ..... 7

Zoomar, Inc. v. Paillard Products, Inc., 258 Fed. 2d 527 (1958) ..... 6

---

## STATUTES CITED

66 Stat. 797, 798, 35 U. S. C. 102, 103 ..... 4

66 Stat. 812, 35 U. S. C. 282 ..... 11

36 U. S. C. A. Sec. 282 ..... 12

# Supreme Court of the United States

OCTOBER TERM, 1959

No. 299

SCRIPTO, INC.,

*Petitioner,*

v.

FERBER CORPORATION,

*Respondent.*

## Respondent's Brief in Opposition to Petition for Writ of Certiorari to the United States Court of Appeals for the Third Circuit

### Introductory Statement

Respondent, Ferber Corporation, opposes the Petition for a Writ of Certiorari on the following grounds:

1—There is *not* here presented, any "real and embarrassing conflict of opinion and authority" (*Layne and Bowler Corp. v. Western Well Works*, 261 U. S. 387, 393, 67 L. Ed. 712, 1923), or any other conflict, between the instant affirming decision of the Court of Appeals for the Third Circuit, and any decisions of the Court of Ap-

*References used herein are: the letter "a", to petitioner's Appendix below; the letter "b", to respondent's Appendix below; "Pet.", to the instant Petition for Writ of Certiorari.*

peals for the Seventh Circuit on the same matter. Petitioner's third paragraph under the heading "Jurisdiction" (Pet. p. 2) is a misstatement.

2—The uncontroverted facts are:

(a)—That the petitioner's three patents were held to be invalid by the Courts below, because they are all covered by the prior art;

(b)—That the record affords sound basis for said findings and conclusions;

(c)—That the Courts below did not, as asserted by petitioner, ignore the presumption of validity attaching to petitioner's patents or the statute expressing it; and

(d)—That there is no conflict between the Third Circuit's decision below and the decisions of the Seventh Circuit.

3—The purported questions posed by petitioner under the heading "Questions Presented" (Pet. p. 2), are not real or warranted. In urging that the Third Circuit differs from the Seventh Circuit concerning the effect of the patent examiner's failure to cite pertinent and relevant prior art, *petitioner has failed* to indicate to this Court:

(a)—That the Seventh Circuit cases relied on by petitioner as being in conflict, all concerned alleged prior art which was expressly found to be not anticipatory and not pertinent to a consideration of the validity of the patent in question and which the examiner might reasonably have concluded did not merit discussion or citation;

(b)—That in cases both preceding and following those relied on by petitioner, the Seventh Circuit has uniformly indicated its adherence to the rule *unanimously accepted*

by the Courts of Appeal of all Circuits which have considered the question, that the absence of citation or mention by the examiner of prior art which is so clearly pertinent and relevant that it ultimately leads the Court to conclude that it anticipated the patent in question, indicates that such prior art had not come to the attention of and was not considered by the examiner before his issuance of the patent, and consequently "weakens" or "detracts from the importance of" the presumption of validity of the patent;

(c)—That the decision in this case did *not* turn on the question now presented by petitioner, since both Courts below found that the evidence clearly demanded a conclusion of prior art anticipation, with consequent invalidity of the patents, and this regardless of the existence or weakening of the presumption of validity.

The issues tried before District Court Judge Hartshorne were limited to the validity, and alleged infringement by respondent Ferber Corporation (hereinafter "Ferber"), of 3 patents held by petitioner Scripto, Inc. (hereinafter "Scripto"), *viz.* #1—mechanical patent No. 2,748,748 (108a); #2—design patent No. 171,093 (89a); #3—design patent No. 176,469 (95a).

Judge Hartshorne's opinion found all 3 patents invalid because they "fail within the prior art" (Pet. p. 11); contained such findings as: "adds nothing to the fund of human knowledge" (Pet., p. 17); "neither new, nor original, nor non-obvious to a person of ordinary skill in the art" (Pet., p. 19); "difference * * * so slight * * * (as not) * * * to rise to the heights of invention" (Pet., p. 19); "not 'new' or 'original'" (Pet., p. 19); "slight changes * * * too minute and insubstantial to be called inventive" (Pet., p. 20); petitioner has made "* * * use of principles which are either actually used in the prior

art or are well known to one employed in such art, * * * " (Pet., p. 17).

The Court of Appeals for the Third Circuit upheld said conclusions of patent invalidity ("primarily because they are all covered by prior art"), by the district court, stating:

> "The record affords sound basis for these conclusions" (Pet., p. 11).

The evidence of relevant, anticipatory prior art patents presented at the trial and contained in said record below, was so clear and compelling as to necessarily overcome and vitiate the presumption of validity attaching to petitioner's patents by virtue of their issuance.

Petitioner does not contend and cannot show that the record fails to support the above quoted factual findings, nor can petitioner avoid their effect to deny patent validity under sections 102 and 103 of the Patent Act of 1952 (66 Stat. 797, 798, 35 U. S. C. 102, 103), which give the conditions for patentability as follows:

Section 102:

> "A person shall be entitled to a patent unless
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country * * *."

Section 103:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be pat-

ented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains * * *."

## Concerning Petitioner's "Statement of the Case" (Pet., p. 3)

Petitioner's "Statement of the Case" repeats allegations (largely immaterial to its instant "Questions Presented"), submitted in its brief below, but which are still not supported by and indeed violate the record.

The issue of patent infringement was not decided, because petitioner's three patents were held invalid. Contrary to petitioner's assertions (Pet., p. 4), the record in the case amply shows that there are vital respects in which the Ferber mechanical construction and design and that "disclosed" in the Lovejoy patents in suit are different; that in the areas of identity in construction, both petitioner and respondent followed the prior art.

What Lovejoy claims to have taken him two and one-half years to develop, namely, a ball point pen "with easily replaceable ink supply which would be attractive and distinctive in design, economical to manufacture and assemble, and which would afford simple, foolproof operation in the hands of the public" (Pet., p. 3), was found by the Courts below to be covered by the prior art (Pet., pp. 11, 14).

On pages 4 to 7 of its petition, petitioner repeats almost parrot-like, bits of testimony and colloquy (out-of-context) which it unsuccessfully used in the Courts below. There are absolutely no facts or arguments printed in its petition which were not before the Court of Appeals. Fur-

thermore, there is nothing in its pages which rightfully belongs in a petition for writ of certiorari.

The petition on its face discloses that petitioner is attempting at this juncture to repeat and re-argue in this Court, under the guise of "questions presented", other contentions which have been expressly rejected by two Courts below.

## *ARGUMENT*

### POINT I

**There is no conflict between the decision of the Third Circuit below, and the Seventh Circuit decisions relied on by petitioner.**

Where evidence of pertinent and relevant prior art is presented to a court, it is *universally held* by *all* of the Courts of Appeal dealing with the matter, *including those of the Third and Seventh Circuits*, that the failure of the patent office to consider such pertinent prior art before issuing a patent in question weakens the presumption of validity which arises from such issuance.[1]

---

[1] 1ST CIR.—*H. Schindler & Co., Inc.* v. *Saladino & Sons, Inc.*, 81 F. 2d 649 (1936); *Viash Refining Co., Inc.* v. *Azor, Inc.*, 158 F. Supp. 505 (D. R. I. 1957); *Robinson Aviation Inc.* v. *Barry Corp.* (D. Mass. 1952), 106 F. Supp. 514; 2ND CIR.—*Zoomar, Inc.* v. *Paillard Products, Inc.*, 258 Fed. 2d 527 (1958); *Gerald M. Friend, Inc.* v. *Walsh*, 141 F. 2d 180 (1944); *National Electric Products Corp.* v. *Grossman*, 70 F. 2d 257 (1934); *R. Hoe & Co.* v. *Goss Printing Press Co.*, 30 F. 2d 271 (1929); 3RD CIR.—*Dole Refrigerating Company* v. *Amerio Contact Plate Freezers, Inc.*, 265 F. 2d 627 (1959); *Messing* v. *Quiltmaster Corp.*, 162 F. Supp. 489 (D. N. J. 1958); *Selas Corp. of America* v. *Purolator Products, Inc.*, 159 F. Supp. 682 (D. N. J. 1958); *Slagboom* v. *Van Vlaanderen Machine Co.*, 139 F. Supp. 785 (D. N. J. 1956); *Osborn Mfg. Co.* v. *Newark Brush Co.*, 111 F. Supp. 846 (D. N. J. 1953); *Rock-Ola Mfg. Corp.* v. *Cusano*, 106 F. Supp. 723 (D. N. J. 1952); 4TH CIR.—*Gillette*

"We are not unmindful of the presumption of validity which attaches to the patent by virtue of its issuance, but that presumption cannot stand against *pertinent* art which was not considered by the Examiner."

*Boynton* v. *Chicago Hardware Foundry Co.*, 77 Fed. 2d 799, *7th Cir.*, 1935.

Where the patent Examiner fails to cite or refer to such relevant prior art, so clearly pertinent indeed that it leads the Court to conclude that it anticipated the patent in question, such non-citation is deemed by the Third and Seventh Circuits, and also by the other Circuits, to indi-

---

*Safety Razor Co.* v. *Cliff Weil Cigar Co., Inc.*, 107 F. 2d 105 (1939); *Maibohm* v. *R. C. A. Victor Co.*, 89 F. 2d 317 (1937); *Specialty Equipment & Machinery Corp.* v. *Zell Motor Car Co.*, 113 F. Supp. 161 (D. Md. 1953); 5TH CIR.—*Fritz W. Glitch & Sons, Inc.* v. *Wyatt Metal & Boiler Works*, 224 F. 2d 331 (1955); *Rosaire* v. *Baroid Sales Division National Lead Co.*, 218 F. 2d 72 (1955), cert. den. 349 U. S. 916, 99 L. Ed. 1249; 6TH CIR.—*Royal Patent Corp.* v. *Monarch Tool & Mfg. Corp.* 203 F. 2d 299 (1953); *O'Leary* v. *Liggett Drug Company*, 150 F. 2d 656, 664 (1945), cert. den. 326 U. S. 773, 90 L. Ed. 467; *Western Auto Supply Co.* v. *American-National Co.*, 114 F. 2d 711 (1940); *Hamilton Laboratories, Inc.* v. *Massengrill*, 111 F. 2d 584 (1940), cert. den. 311 U. S. 688, 85 L. Ed. 444; *Lempco Products, Inc.* v. *Timken-Detroit Axle Company*, 110 F. 2d 307 (1940), cert. den. 311 U. S. 675, 85 L. Ed. 434; *France Mfg. Co.* v. *Jefferson Electric Co.*, 106 F. 2d 605 (1939), cert. den. 309 U. S. 657, 84 L. Ed. 1006 (1940); *Westinghouse Mfg. & Elec. Co.* v. *Toledo, P. C. & L. Ry. Co.*, 172 Fed. 371 (1909); 7TH CIR.—*Hobbs* v. *Wisconsin Power & Light Co.*, 250 F. 2d 100 (1957); *Nordell* v. *International Filter Co.*, 119 F. 2d 948 (1941); *Benjamin Electric Mfg. Co.* v. *Bright Light Reflector Co., Inc.*, 111 F. 2d 880 (1940); *Johnson Laboratories, Inc.* v. *Meissner Mfg. Co.*, 98 F. 2d 937 (1938); *Moran* v. *Protective Equipment, Inc.*, 84 F. 2d 927 (1936); *Boynton* v. *Chicago Hardware Foundry Co.*, 77 F. 2d 799 (1935) 9TH CIR.—*Rohr Aircraft Corp.* v. *Rubber Teck, Inc.*, 266 F. 2d 613 (1959); *Jacuzzi Brothers, Inc.* v. *Berkeley Pump Co.*, 191 F. 2d 632 (1951); *Gomez* v. *Granat Bros.*, 177 F. 2d 266 (1949), cert. den., 338 U. S. 937, 94 L. Ed. 578 (1950).

cate that such pertinent prior art was not considered by the Examiner before he issued the patent. (*American Soda Fountain Co.* v. *Sample*, 130 Fed. 145, at 149, 150, (3rd Cir. 1904), cert. den. 195 U. S. 634, 49 L. Ed. 354, (1904). See also the other cases cited *supra, e.g. Johnson Laboratories* v. *Meissner Mfg. Co.*, 98 Fed. 2d 937, (7th Cir. 1938); *Rohr Aircraft Corp.* v. *Rubber Teck, Inc.*, 266 F. 2d 613, (9th Cir. 1959); *O'Leary* v. *Liggett Drug Co.*, 150 F. 2d 656, (6th Cir. 1945); *Gerald M. Friend, Inc.* v. *Walsh*, 141 F. 2d 180 (2nd Cir. 1944); *Gillette Safety Razor Co.* v. *Cliff Weil Cigar Co., Inc.*, 107 F. 2d 105, (4th Cir. 1939); *Schindler & Co., Inc.* v. *Saladino etc. Inc.*, 81 Fed. 2d 649, (1st Cir. 1936).)

> "The file wrapper shows that the Patent Office in considering the * * * patent cited none of the prior art that is here relied upon; that of the * * * (other) patent (in question) discloses no citation of prior art. Consequently the presumption of validity of either patent is greatly weakened. It cannot stand against pertinent art which was not considered by the examiner".
>
> *Johnson Laboratories* v. *Meissner Mfg. Co., supra,* at p. 943, *C. C. A. 7th.*
>
> "* * * (We) think the force of that presumption (of validity) is much diminished if not destroyed, by the lack of any reference by the Examiner to, or consideration of, the * * * (specified prior art) patents. *It does not seem likely that an expert examiner would pass them by without notice or consideration, if they had been called to his attention*".
>
> *American Soda Fountain Co.* v. *Sample, supra,* at pp. 149, 150, *C. C. A. 3rd.*

The foregoing was the situation presented by the record below. None of the seven pertinent prior art patents listed by the Trial Judge in his "Note 2" (Pet. p. 13), which were relevant on the validity of petitioner's mechanical patent, was cited or referred to by the patent examiner; and the same was true as to the two design patents (Pet. p. 13). In view thereof and in accordance with the universally accepted proposition above set out, the Courts below indicated that the importance of the presumption was lessened (Pet. pp. 11, 13).

Like the Third Circuit, the Seventh Circuit is in accord with the foregoing accepted proposition.

The Seventh Circuit so held in cases *preceding* those cited by petitioner. (*Johnson Laboratories* v. *Meissner Mfg. Co.*, quoted *supra*; *Boynton* v. *Chicago Hardware Foundry Co.*, quoted *supra*; *See also*; *Moran* v. *Protective Equipment, Inc.*, 84 Fed. 2d 927, at 943, C. C. A. 7th, 1936; *Benjamin Electric Mfg. Co.* v. *Bright Light Reflector Co.*, 111 F. 2d 880, C. C. A. 7th 1940; *Nordell* v. *International Filter Co.*, 119 F. 2d 948, C. C. A. 7th 1941).

The Seventh Circuit also so held, 2 years *after* the latest of the cases relied on by petitioner (*Hobbs* v. *Wisconsin Power & Light Co.*, 250 Fed. 2d 100 at 105, *C. C. A. 7th*, 1957).

Nor do the *Artmore* and other Seventh Circuit cases relied on by petitioner (Pet. pp. 8, 9) for the alleged "conflict", say or indicate that the Seventh Circuit does not adhere to the aforementioned proposition which it had already accepted and continued thereafter to accept, in the cases just cited.

In contrast to the situation in which the non-cited prior art was pertinent and relevant and indeed, found by the Court to be anticipatory, is that in which the non-cited

prior art relied on was not pertinent or relevant and did not anticipate.

In that latter situation, where the non-cited prior art urged on the Court is clearly non-pertinent, the mere fact that the examiner did not cite same, does not necessarily indicate that he failed to consider it. Since it is not pertinent, it seems as reasonable to conclude that it was not cited for that reason, as to assume that the examiner overlooked it. Such is the holding of the *Artmore* and other Seventh Circuit cases relied on by petitioner, in each of which the prior art claimed to be anticipatory was expressly held to be not pertinent and non-anticipatory.

The question of what conclusion is to be drawn from the Patent Office's non-citation of prior art, is of course a matter of logical inference. The conclusion will naturally vary depending upon how likely it is that the examiner would have considered the prior art and then discarded it without citation. When the prior art is clearly irrelevant, it is quite likely that the examiner will not trouble to cite it, and the Seventh Circuit accordingly so stated in those cases relied on by petitioner. But when the non-cited prior art is plainly relevant and pertinent—so pertinent, in fact, that it ultimately leads a court to conclude that it anticipated the patent in question—it is wholly unreasonable to assume that the examiner would discard it without citation. This too, the Seventh Circuit Court has held, as has every other circuit court, and it is simply this that the courts below said in the instant case. The two results are not conflicting. They are different sides of the same coin, and in fact, complement each other.

Assuming *arguendo* (although not true) that there is a conflict between the language of those Seventh Circuit cases cited by petitioner, and that of the Third Circuit in the instant case, there is still not that "real and

embarrassing conflict of opinion between the Circuit Courts of Appeal" which should lead this Court to grant certiorari. As noted above, there are several Seventh Circuit cases preceding those cited by petitioner which adhere to the unanimous rule quoted by the Third Circuit in this case. And the most recent statement of the Seventh Circuit on this point (*Hobbs* v. *Wisconsin Power & Light Co., supra*), reaffirms (if such reaffirmation were needed) its position in accord with the position of the Third Circuit and of all of the other circuits which have passed on the question.

## POINT II

**The decision below did not turn on the questions posed by petitioner herein; rested on factual findings of prior art anticipation, compelling a determination of invalidity.**

It is, of course, clear that the presumption of validity of a patent does not bar or prohibit the presentation of evidence showing it to be invalid. The statute says only,

> "The burden of establishing invalidity of a patent shall rest on a party asserting it" (66 Stat. 812, 35 U. S. C. 282; Pet., p. 3).

It is settled that said presumption of validity attaching by the mere issuance of a patent is rebuttable. (*Radio Corp. of America* v. *Radio Engineering Laboratories, Inc.*, 293 U. S. 1, at 8, 79 L. Ed. 163, at 168, 1934; *Westinghouse Electric & Mfg. Co.* v. *Formica Insulation Co.*, 266 U. S. 342, at 348, 69 L. Ed. 316, at 321, 1924; *Steffon* v. *Weber Heating and Sheet Metal Co.*, 237 F. 2d 601, 8th Cir. 1956; *United States Air Conditioning Corp.* v. *Governair Corp.*, 216 F. 2d 430, 10th Cir. 1954).

It is also settled that, while one who asserts a patent's invalidity because of prior art anticipation has the burden of establishing that proposition (36 U. S. C. A. Sec. 282), once the evidence has established such anticipation, the patent must be held invalid (*Rothe* v. *Ford Motor Co.*, 253 F. 2d 353, 355, D. C. Cir., 1958, *Crosley Corp.* v. *Westinghouse Electric & Mfg. Co.*, 152 F. 2d 895, 904, 3d Cir. 1945); and this, even where the patent office had considered such prior art. (*Crosley Corp.* v. *Westinghouse Electric & Mfg. Co., supra; Huston* v. *Buckeye Bait Corp.*, 145 F. Supp. 600, 604-05, S. D. Ohio 1955, aff'd 237 F. 2d 920, 6 Cir. 1956. See, *Lewyt Corp.* v. *Healthmor, Inc.*, 181 F. 2d 855, at 857, 7 Cir., 1950, cert. den., 340 U. S. 823, 95 L. Ed. 605, 1950).

The evidence of the pertinent prior art here presented to the District Court was so complete and compelling, and so clearly established prior art anticipation, that the Courts below were compelled to hold the patents invalid; no rebuttable presumption of validity could sustain the patents in suit in the face of that evidence.

This Court is not interested in reweighing that evidence, and we shall not needlessly burden it with a discussion thereof. A few citations from the opinions below make clear the grounds for the decision, and show beyond doubt that it turned on the compelling weight of the evidence of prior art anticipation and lack of invention, not on any unsettled principle of law demanding this Court's attention.

Thus, as to petitioner's mechanical patent, the Trial Judge found that:

> "An inspection of all this prior art shows that the major additions to human knowledge which were made by the invention of the ball point pen were each and all well known to the public through

this prior art before Lovejoy applied for a single one of his patents * * *. Every single one of these essential characteristics of the ball point pen, as used under the Lovejoy patents by Scripto, * * * is essentially the same as that shown in one or the other of the patents which comprise this prior art; * * *". (Pet., p. 14.)

"Indeed, the only thing which Lovejoy even contends it adds to the art * * * was fully disclosed in the prior art, Lovejoy's device merely making use of the ancient principle of leverage, * * *. So the alleged addition of Lovejoy must have been obvious to a person of ordinary skill in the art." (Pet. pp. 16, 17.)

"* * * since Scripto (Lovejoy) does not even contend that its patent adds anything to the essential characteristics of a ball point pen, and since its sole addition affects a very subordinate part of its mechanism, and by the use of principles which are either actually used in the prior art or are well known to one employed in such art, this patent *clearly* adds nothing to the fund of human knowledge, adn is therefore not patentable." (Pet. p. 17.)

As to petitioner's design patent No. 171,093, evidence of "prior art" patents issued to Furedy, Morrison, Spatz, Kahn, Thull, Biro and Lipic, was introduced, showing slopes or tapers substantially identical with those in petitioner's design. Petitioner's discussion at pages 5 to 7 of its petition, comprises incomplete and out-of-context references, and fails to note that the Trial Judge, after having heard all the evidence and after analyzing the prior art, found that "these sloping shoulders have been known and used in writing instruments by the public for years * * *. Thus the essence of this patent is neither

new nor original * * * nor nonobvious to a person of ordinary skill in the art" (Pet., pp. 18, 19).

As to design patent No. 176,469, plaintiff's attorney admitted at the trial that plaintiff's claim of alleged novelty in this design, lies solely in the incorporation of the release button in the clip (76b; 77b). Evidence of "prior art" patents to Bouhier, Kimberly and Rosa was presented, all showing prior use of release buttons located in the clip. (As to the Bouhier patent, petitioner cites the obscurity of the patent drawing reproduction in evidence (Pet., p. 7); fails to advise this Court that petitioner's attorney finally conceded in open court that the release button "goes through the clip" (102b).) The Trial Judge accordingly found petitioner's claim *not* "new" or "original", but fully covered in the prior art (Pet., pp. 19, 20).

Thus, the uncontradicted evidence of anticipatory prior art, which clearly negatived any inventive features of the claims of the patents in suit, compelled the factual findings of invalidity of the courts below.

## CONCLUSION

**For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.**

Respectfully submitted,

MAXWELL E. SPARROW,
MILTON ROSENKRANZ,
*Attorneys for Respondent.*